



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,992	06/14/2001	Bill DeSane	684.1002	9837

21831 7590 06/13/2005

STEINBERG & RASKIN, P.C.
1140 AVENUE OF THE AMERICAS, 15th FLOOR
NEW YORK, NY 10036-5803

EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
----------	--------------

3624

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/882,992

Applicant(s)

DESANE, BILL

Examiner

JAGDISH PATEL

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to amendment filed 1/7/05.

Response to Amendment

2. Claims 8 and 12 have been amended. All other claims remains as original claims.

Response to Arguments

3. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC §101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

5. Claims 1-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The invention as recited in the claims is merely an abstract idea that is not within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter.

Art Unit: 3624

The examiner presents the following rulings in support of the aforementioned analysis.

The phrase “technological arts” is synonymous with the phrase “useful arts” as it appears in Article I, Section 8 of the Constitution, *In re Waldbaum*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974).

More recent ruling by the U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences (*Ex Parte Bowman*, 61 USPQ2d 1669) also supports the assertion that an invention must “promote the progress of science and the useful arts” and that the invention must fall within the definitions of technological arts in order to be statutory under 35 U.S.C. 101. Note that the Bowman ruling cannot be used as a precedent but cited for its analysis of the claims for patentability under 35 U.S.C. 101.

None of the claims are recited within technological art. The method steps of purchasing, satisfying and reselling are interpreted as manual process steps as is well known in the art of real estate transaction processing. The steps of determining and calculating recited in claims 2-14 are broadly interpreted as manual process performed without any technological means. Likewise the process steps recited in method claims 15-19 are also manually performed steps. Therefore, the pending method claims are outside technological art and deemed non-statutory under 35 U.S.C. 101.

In order to overcome this rejection, the aforementioned limitations must be recited as being performed by a server or a processor and support for technological implementation must be found in the disclosure per written description and enablement requirement under 35 USC § 112 (first paragraph).

Art Unit: 3624

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 2 recites step determining a total cost Tc for purchasing the property from the debtor, satisfying the debtor's personal debt and reselling the property back to the debtor at a present appraised value of the property. This steps does not functionally relate to the previous steps of the claim because it is carried out regardless of the individual steps which calculate or determine various parameters related to the method.

9. dependent claims 3-14 also inherit same deficiency.

10. Claim Rejections - 35 USC § 102

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

11. Claim 1 and 15-19 are rejected under 35 USC § 102(b) as being clearly anticipated by Barchard et al., "Lenders aim to halve home repossessions" Financial Times, p.8 December 20, 1991 (Barchard).

Art Unit: 3624

Per claim 1, Barchard teaches a method for restructuring the debt of a debtor who has an interest in a distressed property comprising the steps of:

Purchasing said distressed property from said debtor ..(Abbey National buying back the properties at current market value, see p.2 top paragraph);

Satisfying said debtor's outstanding personal debt (see p.1 Abbey National offers this scheme to employed borrowers who are in arrears and who do not receive government assistance, inherently suggesting that the purpose of the scheme is to satisfy the debtor's (borrower's) personal debt such as the outstanding mortgage balance);

Reselling said property back to said debtor at an appraised present value of the home (see paragraph 2, "should the circumstances change, the tenants would be in a position to buy back the property at its prevailing market value).

Regarding claims 15-19, Barchard inherently or explicitly teaches all limitations of the concepts recited in the instant claims.

Conclusion

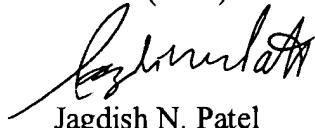
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571)272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

6/6/05